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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/655,886	09/06/2000	Jeffrey L. Hirka	47004.000084	8892

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EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT PAPER NUMBER

3628

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/655,886

Applicant(s)

HIRKA ET AL. 

Examiner

Siegfried E. Chencinski

Art Unit

3628

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-51.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: PTO 1449

  
HYUNG SOUH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

Continuation of 5. does NOT place the application in condition for allowance because: 1. Applicant has failed to present claims and a supporting disclosure which is narrow enough to exclude the Atkins reference on the basis of anticipating Applicant's invention. This includes the definition of "sweeps". In the absence of Applicant's taking advantage to be their own lexicographer by defining sweeps narrowly within the general notion of sweeps, the examiner must give the broadest reasonable definition to the "sweeps" term which is consistent with the art in question.

2. The Atkins reference anticipates a broader invention than that of Applicant while incorporating applicant's claimed limitations. Atkins presents the purpose of his invention as "an integrated financial product package with a system of exchange, investment and borrowing that incorporates financial analysis, planning and management" (Col. 1, ll. 19-27). Atkins' Abstract begins as follows: "A practical communication and computer system and method for effecting exchange, investment and borrowing involves the use of digital communications" (ll. 1-3). Hence, the management of cash through a linked cash account is an element of these "management" and "exchange" features. Further, Atkins aims his invention at financial institutions by suggesting that his invention creates the possibility for a financial institution to make a greater profit from a customer who buys this service package from them (Col. 11, ll. 3-63). Atkins suggests an "infinite number of investment opportunities" for a financial institution to sell to a customer. The comprehensive Atkins financial service package necessarily presents automated features of managing a bundle of financial assets and liabilities which, if so selected by the customer, permits the customer to leverage the customer's assets with loans and lines of credit. The cash account is an integral and inherent component to transactional execution features of this service package, since some of the transactional features could not be performed without a cash account. The Atkins system without a cash account would not be very convenient and attractive, since the customer would be forced to participate in some of the transactions every month. Further, beyond being inherent in Atkins, Atkins describes the role of cash accounts in his system in a number places, such as in Col. 10, ll. 4 & 46-50. As such, Atkins presents a full service context which includes account sweeps which include cash accounts among them (Col. 7, ll. 42-44; Col. 8, l. 43). Applicant is also pointed to the several references by Atkins to the management of Asset and Liability accounts. A cash account is one such asset account, of which there is a variety of versions, including checking, savings, money market, etc. Some type of cash account is required for the Atkins service system to function.

3. Regarding Applicant's argument about the requirements of anticipation (p. 3, ll. 10-15), Applicant is advised of the following: "[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on 'inherency' under 35 U.S.C. 102, on 'prima facie obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).

4. Regarding Applicant's argument that Atkins "relates to a subject matter substantially different from the present invention" (p. 2, ll. 9-10): First, the examiner's view is that Atkins and Applicant's invention are in the same area of art, namely financial services. Secondly, Applicant is asked to note the following excerpt from the MPEP: 7.37.05 Unpersuasive Argument: Nonanalogous Art In response to applicant's argument that Atkins is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Atkins is very reasonably pertinent to the particular problem with which Applicant was concerned.